

contents up to 90% and teaches up to 50% as preferred. The term "consisting essentially of" does not exclude ingredients that do not change the function of the composition. The additional "polymer" content over that stipulated in claim 13 is not, therefore, excluded either by the term "consisting essentially of" or by the amount of the polymer acting as a "cohesive strength improving" agent. The claims, therefore, still read on the components taught by Horsey et al and the presumption that the compositions taught would possess the required "hot tack properties" is still valid.

There are many adhesive applications. Each application of adhesive depends on the physical properties of the adhesive material. Properties derive from the blended components of the adhesive. Each individual component has some impact on properties. Omitting a component can profoundly affect the properties.

The claims are directed to a hot melt pick-up adhesive. The color, softening point and viscosity are characteristic of such an adhesive. These characteristics are required for hot pick-up utility, but would render a typical general-purpose hot melt adhesive relatively useless in its ordinary application.

The Horsey et al. disclosure is a broad compositional disclosure having little or no information on the properties of the adhesive or the applicability of the adhesive to end uses. Adhesive compositions are carefully formulated materials that obtain viscosity, tack, open time, etc., and as a result of these properties have specific uses in a variety of applications. An adhesive prepared for use as a general purpose hot melt adhesive cannot be used in other applications such as in tab attachment, absorbent article construction, contact lens applications or other applications since its properties would result in failure of the material to either machine (successful applications by automated equipment) or would fail in its end use as a result of its possession or lack of certain properties required for the end use. The Horsey et al. technology cannot be used as a hot pick up (HPU) material. The reference apparently teaches a general-purpose hot melt adhesive material. The materials disclosed by Horsey et al. appear to be useful in case and carton seal application. These materials are not suitable for use in hot pick-up applications at least because of high viscosity and short open times.

The attached Quinn declaration demonstrates the profound effect of the polymer on the properties of the adhesive materials. The HPU exemplified uses only the hydrogenated resin and

oil with no polymer. This material has a viscosity that is substantially lower than the polymer containing material. The HPU also has an extended open time not shown in the polymer containing material. The polymer renders the adhesive worthless for HPU applications. In summary the polymer has a profound effect on the materials and the use of the phrase "consisting essentially of" does distinguish the materials of the invention from prior art.

It would not be obvious to modify the typical hot melt adhesive to (1) use a hydrogenated resin in an HPU, and (2) to remove the polymer components since, in this industry, it has been assumed that the hot pick-up material requires a polymer component for successful application. To date, no successful hot pick-up adhesive has been manufactured in the absence of a polymer component.

The omission of an essential element from a patent while retaining essential properties is indicia of patentability.

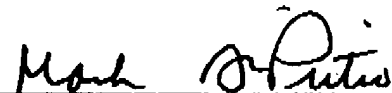
#### CONCLUSION

Applicant asserts that the claims as written in the case are allowable since the common pressure sensitive adhesive material shown in the reference cannot possess the color, softening point and viscosity recited in the claims.

In view of the above remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

15 June '05  
Date

  
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